

## REMARKS

Applicants request favorable reconsideration and withdrawal of the rejections set forth in the above-noted Office Action in view of the foregoing amendments and following remarks.

Initially, Applicants note that Information Disclosure Statements were filed on November 21, 2006, and September 29, 2006, in the present application. Applicants have not yet received copies of the PTO-1449 forms attached to these Information Disclosure Statements to indicate that the Examiner has considered the references cited therein and that the references have been officially made of record. Accordingly, it is requested that the next Official communication include copies of the PTO-1449 forms.

Applicants further note that a copy of the PTO-1449 form that was included with the Information Disclosure Statement filed on September 14, 2006, was attached to the July 17, 2007 Office Action. The references cited on this copy of the PTO-1449 form, however, were not marked as considered by the Examiner. Accordingly, Applicants request the next Official communication include a copy of this PTO-1449 form indicating consideration of the cited references by the Examiner.

Claims 1, 2, 5-13, 16-19, 21, and 22 remain pending, with claims 1, 12, 16, 17, 21, and 22 being independent. Claims 15 and 20 have been cancelled without prejudice or disclaimer of subject matter. Claims 12, 17, and 22 have been amended. Support for the amendments can be found throughout the originally-filed disclosure, including, for example, at paragraph 0026 of the specification. Thus, Applicants submit that the amendments do not include new matter.

Claims 1, 2, 4-13, and 15-22 are rejected in the Office Action under 35 U.S.C. § 103(a) as being unpatentable over Levine et al. (U.S. Patent No. 5,477,038) in view of Shimizu et al. (U.S. Patent No. 5,898,158) and Applicants' disclosed art (“AAPA”).

Applicants respectfully traverse the rejection. Nevertheless, without conceding the propriety of the rejection and solely to expedite prosecution, independent claims 12, 17, and 22 have been amended to clarify certain features of the invention not suggested by the cited references. To this end, Applicants submit that amended independent claims 12, 17, and 22, as well as independent claims 1, 16, and 21, are patentably distinguishable for at least the following reasons.

The independent claims recite various methods, systems, and devices for distributing a transaction account card, or distributing a transaction account that is associated with a card. In all of the independent claims the cards are recited as credit or debit cards.

The Office Action cites Levine et al. as disclosing a method and corresponding system that includes features of the claimed invention. The Office Action acknowledges, however, that Levine et al. does not disclose a transaction account card used with the method and corresponding system to be a credit card or a debit card, but rather a prepaid card. In order to cure this deficiency, the Office Action cites Shimizu et al. as teaching the concept of alternatively using a credit card or bank card in place of a prepaid card. The Office Action concludes that it would have been obvious to one of ordinary skill in the art to modify the teachings of Levine et al. to use credit or bank cards as alternatives to the reference's disclosed prepaid cards in order to increase flexibility of Levine et al.'s method and system.

Applicants respectfully traverse the Office Action's conclusion that one of ordinary skill in the art would view credit or debit cards as viable alternatives to the prepaid card in the method and system of Levine et al. A reference must be considered in its entirety, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). In this case, the modification of Levine et

al. set forth in the rejection runs directly contrary to the express teachings of Levine et al., who discloses:

The card is not embossed to prevent its use as a credit or debit card. Fraud possibilities are thus limited because it cannot be used to produce imprints like a credit card or debit card. There is no need for an expiration date as for a credit card since there is no need for credit controls because the money has already been received by the issuer.

Col. 4, lines 4-9 (Emphasis added).

It is improper to combine references in a Section 103 rejection where the references teach away from the combination. In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983); MPEP § 2146. This is precisely the case with the modification of Levine et al. set forth in the rejection. Levine et al. expressly discloses that the cards to be used with the disclosed system and method are not to be credit or debit cards for definitive reasons, i.e., reducing fraud possibilities and eliminating the need for expiration dates. This express teaching away from the claimed invention by Levine et al. cannot be ignored when considering whether it would have been obvious to modify the reference in the manner set forth in the Office Action.

Applicants further respectfully submit that the disclosure of Levine et al. negates the reasoning asserted in the Office Action for modifying the reference, i.e., that one of ordinary skill in the art would view of view the use of a credit card or debit card as a viable alternative to Levine et al.'s prepaid cards in order to increase flexibility in the methods and system disclosed in the reference. As discussed above, Levine et al. discloses that credit and debit cards should not be used in the reference's disclosed system and method because of the fraud potential that would be introduced in the method and system with such cards. In this regard, it is notable that Shimizu et al. discloses the use of credit and debit cards in a completely different context than

Levine et al. That is, while Levine et al. is concerned with distributing currency, Shimizu et al. discloses accepting credit and debit cards for settlement of accounts. Thus, even if Shimizu et al. is taken to suggest the alternative use of credit, debit, and prepaid cards for settlement in some contexts, this does not lead to conclusion that the cards would be viewed as alternatives to one of ordinary skill in the art in completely different distribution methods and systems of Levine et al., especially given Levine et al.'s express disclosure against the use of credit and debit cards in the particular distribution method and system of the reference.

In sum, Applicants submit that Levine et al. expressly teaches away from the modification to use credit or debit cards with the disclosed methods and system in the reference, and that the disclosure of Shimizu et al. is insufficient to conclude that one of ordinary skill in the art would disregard the definitive teachings of Levine et al.

Applicants further submit that the art disclosed in the present application (AAPA), which is also cited in the Office Action, fails to cure the deficiencies of Levine et al. and Shimizu et al. Indeed, the Office Action does not assert AAPA to include the above-discussed features of the invention.

For at least the foregoing reasons, Applicants submit the invention recited in the independent claims of the present application is patentable over the combination of Levine et al., Shimizu et al., and Applicants' disclosed art.

The dependent claims should also be deemed allowable for defining features of the invention in addition to those recited in their respective independent claims. Favorable individual consideration of the dependent claims is requested.

Applicants submit that the present application is in condition for allowance. Favorable reconsideration, withdrawal of the rejection set forth in the Office Action, and a Notice of Allowability are requested.

Applicants' undersigned attorney may be reached in our Washington, D.C. Office by telephone at (202) 530-1010. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

/Donald H. Heckenberg, Jr./

---

Donald H. Heckenberg, Jr.  
Attorney for Applicants  
Registration No. 60,081

FITZPATRICK, CELLA, HARPER & SCINTO  
30 Rockefeller Plaza  
New York, New York 10112-3801  
Facsimile: (212) 218-2200

FCHS\_WS 2771428\_1.DOC